

REMARKS

The present amendment is in response to the non-final Office action dated February 27, 2006, where the Examiner has rejected claims 1 - 19 and allowed claims 20 - 21. In the present amendment, claims 1, 5, 9, 15 and 18 have been amended. Accordingly, claims 1 - 21 are pending in the present application with claims 1, 5, 9, 15, 18, and 20 being the independent claims. Claims 20 and 21 have been allowed.

Please note that a supplemental IDS was filed March 14, 2006 which included references from an International Preliminary Report on Patentability (IPRP) issued on February 16, 2006 from the IPEA/US. The IPRP included three references already cited by the present Examiner in the "Notice of References Cited" issued with the first Office Action dated August 10, 2005. Therefore, there are no new references for consideration.

Reconsideration and allowance of pending claims 1 - 19 in view of the amendments and the following remarks are respectfully requested.

A. Allowed Claims

The Examiner has allowed claims 20 and 21. Applicant respectfully requests a notice of allowance for at least claims 20 and 21.

B. Rejections under 35 USC §103(a)

In the Office Action, claims 1 - 19 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,959,192 ("Cannon") in view of U.S. Publication No. 2004/0229644 ("Heie").

With respect to independent claim 1, the Examiner combines Cannon and Heie and asserts that the combination makes independent claim 1 obvious. The Examiner asserts that the combination of the two references would have made obvious to one of ordinary skill in the art at the time that invention was made to provide the update communication comprising the new area code as taught by Heie to the method of

Cannon in order to update to a new telephone area code in the new location without any manual intervention required by the user.

However, lack of user manual intervention is not an element of independent claim 1. *Instead, the claimed elements include the limitation that the area code of the wireless communication device itself be updated.* The combination of Cannon and Heie do not teach this limitation. The rejection of claim 1 based on Cannon and Heie is hereby traversed as follows:

An invention is unpatentable if the differences between the invention and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a prima facie case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

1. Suggestion or Motivation to Combine

In the Office Action, no motivation has been identified for combining the references or to make the necessary modifications to arrive at the amended claimed invention and no such motivation exists. Cannon teaches a method for providing a handset with geographic awareness information so that the area code that the handset is physically in is known by the handset. Cannon teaches that this geographic awareness information solves the 7 digit number problem... namely the problem associated with phone book entries on the handset with only 7 digit numbers (no area codes). Thus, Cannon teaches that if a handset is provided with its current area code information, then the 7 digit numbers that it dials can use the current area code as the default so that the 10 digit numbers that are required for communication are valid.

On the other hand, Heie teaches a method for en masse updating of entries in the phone book of a handset. While Cannon deals with phone numbers that do not have an area code associated with them (the 7 digit number problem), Heie requires that a phone number stored in a phonebook on a handset have an area code number since Heie teaches replacing the area code with a new area code. Accordingly, no proper combination of Cannon and Heie can be made because the teachings contradict each other, with Cannon requiring no area code and Heie requiring an area code.

Thus, Cannon and Heie provide no motivation, teaching, or suggestion to combine their teachings or to make the necessary modifications to arrive at the claimed invention. Furthermore, the Office Action identifies no motivation, teaching, or suggestion within the references that supports the conclusion that the references can be properly combined. Instead, the Office Action simply asserts that "it would have been obvious to one skilled in the art at the time the invention was made to provide the update communication comprising the new area code as taught by Heie to the method of Cannon in order to update to a new telephone area code in the new location without any manual intervention required by the user." The simple assertion that it would have been obvious to combine references is not sufficient for the Office Action to meet its burden to demonstrate a prima facie case for obviousness.

Applicant respectfully submits that the only logical connection between the references is the general concept of area codes, and that the cited prior art is being combined by the Examiner in retrospect, in light of the present invention. That is, the obviousness rejection is based upon the Applicant's own invention characterization, not any identifiable suggestion to combine Cannon and Heie.

The pertinent authority relating to 103(a) rejections is clear:

"[t]herefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue [...]. To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that would create the case of obviousness. In other

words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art reference for combination in the manner claimed." In re Rouffet, 47 USPQ2d 1453, 1457-1458 (1998).

Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Thus, Applicant respectfully submits that the first requirement of the obviousness analysis is not met.

2. Reasonable Expectation of Success

The Office Action makes no attempt to demonstrate any reasonable expectation of success in the present invention suggested by Cannon and Heie if their teachings were combined. In fact, the contradicting disclosures demonstrate that no such success exists. Cannon clearly requires that no area code exists while Heie clearly requires that an area code exist. Thus, Applicant respectfully submits that the second requirement of the obviousness analysis is not met.

3. Combined References Must Teach All Claim Limitations

The cited combination of references does not suggest all the limitations of the amended claimed invention because they do not teach updating the area code portion of the unique identifier of the wireless communication device itself.

Specifically, Heie, which the Examiner cites as teaching this limitation, only teaches that the telephone numbers in the phone book on the handset be updated. That does not teach the claimed invention. The claimed invention requires that the phone number of the handset itself be updated. That phone number is the unique identifier for the handset on the wireless communication network. The various telephone numbers in the phone book on the handset are in no way related to uniquely identifying the handset on the wireless communication network. Accordingly, Heie cannot and does not teach the claimed invention.

Furthermore, Cannon does not teach the claimed invention because Cannon also does not teach the updating the area code portion of the unique identifier of the wireless communication device itself. Instead, recall that Cannon teaches how to solve the 7 digit number problem. Specifically, Cannon outlines the problem it solves at column 1, lines 43 – 52, which states that:

the numbers stored in the speed dial function typically assume the call will be made within the user's typical local area code and therefore generally are not provided with an area code. If the user travels outside of his local area and into a different area code or country, the speed dial function will no longer work as the area code and possibly a country code will be required to place the call.

Thus Cannon discusses how to solve this problem and teaches a method to provide the handset with its current area code and country code information so that the 7 digit speed dial numbers can be validly called. No where does Cannon teach, suggest, or even discuss any modification of the area code portion of the unique identifier of the wireless communication device itself.

Applicant asserts that while both Cannon and Heie discuss area codes, that a close inspection of each reference clearly demonstrates that neither contemplates the modification of the area code portion of the unique identifier of the wireless communication device itself and therefore neither of the references individually teach the invention and the combination of reference also fails to teach the claimed invention.

In summary, neither Cannon nor Heie teaches the claimed invention and Applicant respectfully submits that the third requirement of the obviousness analysis is not met.

Independent claims 1, 5, 9, 15, and 18 include similar limitations that are not taught by Cannon and Heie individually or in combination and Application therefore submits that pending claims 1 - 19 are presently in condition for allowance and a notice of allowance of claims 1 - 19 in addition to already allowed claims 20 - 21 be issued.

C. Conclusion

In view of the above assertions, Applicant respectfully requests that the Examiner issue a notice of allowance for claims 1-19 as well as for the allowed claims 20-21.

If necessary, applicant requests under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application and to charge the fees for a large entity under 37 CFR 1.17(a). The Director is authorized to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Deposit Account No. 50-3001 of Kyocera Wireless Corp.

Should the Examiner believe that prosecution of this application might be expedited by further discussion of the issues, she is invited to telephone the attorney for Applicant at the telephone number listed below.

Respectfully submitted,

Dated: May 26, 2006

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